

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Ian Daniel VON FELLENBERG, et al.
 Serial No.: 10/521,124 Group No.: 2876
 Filed: August 3, 2005 Examiner: J. Franklin
 For: SECURITY DOCUMENT AND VERIFICATION METHOD

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

CERTIFICATION UNDER 37 C.F.R. 1.8(a) and 1.10*

(When using Express Mail, the Express Mail label number is **mandatory**; Express Mail certification is optional.)

I hereby certify that, on the date shown below, this correspondence is being:

MAILING

- ☐ deposited with the United States Postal Service in an envelope addressed to the Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450.

37 C.F.R. 1.8(a)

- ☐ with sufficient postage as first class mail.

37 C.F.R. 1.10*

- ☐ as "Express Mail Post Office to Address"
Mailing Label No. _____ (mandatory)

TRANSMISSION

- ☐ transmitted by facsimile to the Patent and Trademark Office, to **(571)-273-8300**

EFS-~~WEB~~

- ☒ transmitted electronically

Date: May 5, 2009

Signature

John Richards

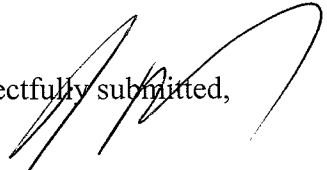
(type or print name of person certifying)

- *Only the date of filing (§ 1.6) will be the date used in a patent term adjustment calculation. Consider "Express Mail Post Office to Addressee" (§ 1.10) or facsimile transmission (§ 1.6(d)) for the reply to be accorded the earliest possible filing date for patent term adjustment calculations.*

The review is requested for the reason(s) stated on the Attached Sheet(s).

NOTE: No more than five (5) pages may be provided.

Respectfully submitted,



John Richards
c/o Ladas & Parry LLP
26 West 61st Street
New York, New York 10023
Reg. No. 31053
Tel. No. (212) 708-1915

ATTACHED SHEETS

In the Amendment After Final Rejection filed on March 5, 2009, Applicants attempted to cancel rejected claims 1-4 and 6, without conceding the propriety of those rejections, in an earnest effort to reduce the number of issues and advance the case to issue. However, the Examiner did not enter the Amendment After Final Rejection, and, therefore, claims 1-4, 6, 7, 9-11, and 13-21 remain pending in this application. Applicants submit that all of the pending claims are patentable.

Claims 1, 7, and 21 are independent.

The rejection of Claim 1 under 35 U.S.C. 102(e) as being anticipated by Cobben

Claim 1 is directed to a method for verifying the authenticity of a document. The claim recites, *inter alia*, “viewing the document from at least one viewing direction that is non-perpendicular to a surface of the carrier and deriving the authenticity from an optical transmission of said perforations in said viewing, wherein the perforations extend through the carrier in a direction perpendicular to said surface.” Nothing in Cobben would teach or suggest the features of claim 1.

Cobben does not teach or suggest non-perpendicular viewing of perpendicular perforations, as in claim 1. The only instance in which Cobben discusses non-perpendicular viewing is in the case of non-perpendicular perforations (see column 4, lines 6-8). In the final Office Action the Examiner points to column 5, lines 8-14 and 25-27 of Cobben. That portion of Cobben states “wherein the perforation pattern is adapted to present to the user an image which differs per angle of view.” However, this refers to the viewing of oblique perforations (e.g., column 4, lines 4-6 and 25-29), not perpendicular perforations. Specifically, column 4, lines 4-6 discusses perforations which are “arranged obliquely, i.e., at an angle differing from 90 degrees,” and refers to Fig. 2, which shows oblique perforations.

And column 4, lines 25-29 provides:

Owing to the fact that both perforations 4 are arranged obliquely, it is possible to provide these perforations with extra information, for instance by arranging them in the form of a letter or a logo. This is of course only visible when the image is viewed at a determined angle.

Applicants submit that nothing in Cobben would teach or even suggest that a non-perpendicular viewing of perpendicular perforations would make any sense. As quoted above with respect to column 4, lines 25-29, Cobben states that it is possible to provide these perforations with extra information *owing to the fact that both perforations 4 are arranged obliquely*. Cobben further states that this is of course only visible *when the image is viewed at a determined angle*.

MPEP 2131 provides that to anticipate a claim, the reference must teach every element of the claim. Cobben does not teach a verifying method including viewing a document as recited in claim 1 from at least one viewing direction that is non-perpendicular to a surface of the carrier, the perforations, at least part of them having an elongate cross section, extending through the carrier in a direction perpendicular to the surface, as explained above. Accordingly, Cobben cannot anticipate claim 1.

The rejection of Claim 7 under 35 U.S.C. 102(e) as being anticipated by Cobben

Claim 7 recites a security document including a carrier and a security feature with perforations in the carrier, wherein at least one of the perforations has an elongate cross section with a minimum and a maximum diameter, at least two of the perforations have different cross sections, the perforations extend through the carrier perpendicular to a surface of the carrier, and the cross sections have equal areas. By virtue of the features of claim 7, the different types of holes are indistinguishable when orthogonally viewing the carrier, but generate a difference when obliquely viewing the carrier. Nothing in Cobben would teach or

suggest these features.

The final Office Action cites column 4, lines 10-15 and 44-47 of Cobben as teaching at least two perforations having different cross sections, and cites Figs. 3 and 4 as teaching the cross sections having equal areas. However, claim 7 requires, *inter alia*, perpendicular perforations, at least one of which is elongate. Fig. 3 of Cobben does not show perpendicular holes at all, and nevertheless shows holes with modulated widths, i.e., different diameters; while Fig. 4 shows perpendicular holes, there is nothing to indicate that those perpendicular holes are elongate. The cited portions of column 4 refer to an embodiment apparently having holes of *varied* area, unlike in claim 7, since (lines 10-15) the hole diameters are modulated, from which it follows that the areas of the holes are varied in the absence of any suggestion that the cross sections have equal area. Moreover, it is submitted that the Examiner has not made out a proper rejection on anticipation, since the Examiner appears to be picking and choosing from different embodiments of Cobben in order to find that claim 7 is anticipated by that patent. Even so, a security document having the features recited in claim 7 is not taught by Cobben.

Yet, in the *Response to Arguments* section of the final Office Action, at page 7, the Examiner states:

In the instant that the Cobben invention is made up of more than one perforation having an oval shape, then that cross section of that one perforation is indeed “different” than the cross section of another perforation, as broadly interpreted.

Applicants have carefully reviewed the Examiner’s statement, and, to the extent they understand it, completely disagree. It appears that the Examiner is interpreting the term “cross section” to refer to the physical hole of a perforation, such that two spatially separated perforations will always have “different” cross sections. However, the recitation in claim 7 “wherein at least two of the perforations have different cross sections” clearly refers to the shape of the perforations. The Examiner states that she is “broadly” interpreting the claims,

but MPEP 2111 calls not for the “broadest interpretation” but for the “broadest reasonable interpretation,” and one that is consistent with the specification and with the interpretation that those skilled in the art would reach. (Emphasis added.) The present specification, for example, at page 5, lines 33-34, states that “In another embodiment, the holes have cross sections of different shape.” Therefore, from the specification it is clear that the claim term “different cross sections” refers to the shape of the perforations. It is not reasonable under MPEP 2111 for the Examiner to interpret the claim recitation “different cross sections” such that any two spatially separated perforations -- even if shaped the same -- would have physically “different” cross sections.

For at least the foregoing reasons, claim 7 is seen to be clearly allowable over Cobben.

The rejection of Claim 21 as being unpatentable over Cobben in view of Kimura

Claim 21 is directed to a security document comprising a carrier, a first type of perforations in the carrier having elongate cross section, and a second type of perforations in the carrier having circular cross section. The elongate cross section has an equal area as the circular cross section, and the first and second types of perforations extend through the document in a direction perpendicular to a surface of the carrier. (See, e.g., Fig. 5 and page 5, line 34 to page 6, line 3 of the present specification.)

At page 7 of the final Office Action, the Examiner states that “the Cobben invention is relied upon to teach the circular cross section and the Kimura invention is relied upon to teach the elongated cross section.”

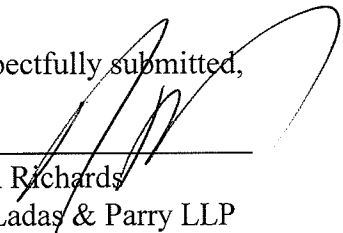
Kimura may teach perforations with elongate cross section, and Cobben perforations with circular cross section. However, claim 21 further specifies that both cross sections should have equal area. Even if the teachings of Cobben and Kimura were combined (even though it is unclear for what motive), the prior art provides no reason why the two types of perforations should have equal cross section. In fact, a person having ordinary skill in the art

would likely manufacture the perforations such that the smaller diameter of the elongate perforations is equal to the diameter of the circular perforations, such that both types of perforations can be manufactured with a single, circular laser beam which, during the duration of a laser pulse, is moved along the paper (for the elongate perforations) or stationary (for circular perforations). For perforations manufactured in this manner, the elongate perforations would have larger area than the circular perforations.

For at least the foregoing reasons, claim 21 is seen to be clearly allowable over Cobben and Kimura.

Reconsideration and allowance are, therefore, requested. Should it be the decision of this Panel to re-open prosecution, it is respectfully requested that a brief summary of the Panel's reasons be provided to Applicant so that it is clear which issues prosecution is being re-opened for.

Respectfully submitted,



John Richards
c/o Ladas & Parry LLP
26 West 61st Street
New York, New York 10023
Reg. No. 31053
Tel. No. (212) 708-1915